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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,220	08/19/2003	Kiyotaka Ohara	116382	3455
25944	7590	11/02/2005	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			DEBROW, JAMES J	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/643,220	Applicant(s) OHARA, KIYOTAKA	
	Examiner James J. Debrow	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19Aug2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/19/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>25Jun04 & 6Jul05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Application filed on 19 Aug 2003.
2. Claims 1-21 are pending in this case. Claims 1, 8, 15-21 are independent claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-4, 8-11, and 15-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Shima (US 6,362,894 B1; Date of Patent: Mar. 26, 2002; Effective Filing date Nov. 25, 1998) ('Shima-894').**

With regards to independent claims 1, 8, 15-21, Shima-894 discloses a printing system for printing over a network. The system consists of a file server, which is connected to the Internet via a router, and stores various information resources (*location data*) (column 5, lines 15-17; 103 in Fig 1). For example, a webpage can be stored on the server. Not only is the webpage stored on the server, it's URL (*location data*) is also stored on the server. Having the URL stored on the server, gives the system quick access to the specific webpage when trying to access it per user request;

a network printer for printing out the obtained print data. As with the current invention, Shima-894 network printer contains a Receive Control Section (*location data request and receiving system*) for receiving *location data* that is downloaded from the server, a Memory (*data storage*) for storing data downloaded from the server, and a Printing Control Section (*printing device*) for printing the data downloaded from the server (column 5, lines 37-38; column 5, lines 62-64; column 5, lines 51-52; 11 in Fig 1; 13 in Fig 1; 14 in Fig 1; 16 in Fig 1). From the webpage example, the webpage's URL (*location data*) is stored in a URL storage subsection (column 6, lines 43-44; 20 in Fig 1) of the storage section (*print data*) of the printer (19 in Fig 1). The printer requests (*locating data requesting system*) the server to transfer information according to the determined format, ie TXT, HTML, JPEG, etc. (*location data of the print data based on the data stored in said data storage*). After the server generates the *location data of the print data* (this would inherently happen after the server locates the requested webpage), it transfers (*data transmitting system*) the required information to the printer. Once the printer receives the information, it generates print image data and prints the document (column 6, lines 33-36). The printer is capable of accessing information resources without using the host computer (column 2, lines 41-44; column 7, lines 28-29; 2 in Fig 1); a computer accessible recording medium that contains a printing control program for receiving and printing information resources on the network. The program enables the host computer means for performing all aforementioned functions as if it were operating as the file server or the network printer (column 4, lines 16-32). As in the

current invention, Shima-894 system components (server, printer, and computer) are capable of two-way (transmit and receive) communications within the network.

With regards to dependent claims 2 and 9, Shima-894 doesn't explicitly disclose a mechanism for updating the resources (*location data*) stored in location data storage, however it would be inherent to anyone of ordinary skill in the art that there would be such a mechanism in place, as the data in most databases is not constant. There is always at least one mechanism for adding and deleting information within the database.

With regards to dependent claims 3 and 10, Shima-894 discloses a URL storage subsection within the network printer for storing a URL specified by the host computer (column 6, lines 10-11; 20 in Fig1). Based on the established meaning of an URL, the scope of this subsection is identical to the scope of the current invention *designating system to designate one of a plurality of locations, which are indicated by the location data, corresponding to the print data to be printed.*

With regards to dependent claims 4 and 11, Shima-894 discloses a process to determine whether the data received by the printer is printable or unprintable data. Shima-894 uses a format management table to determine whether the format of specific data is receivable (print data) or un-receivable (*unprintable data*) (column 6, lines 11-18; Fig 2). Even though Shima-894 doesn't explicitly state that both printable and

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unprintable data are stored on the server, and that the location data generating system generates a location for both, and transmits them, this is nevertheless implied, because in order for the printer to distinguish printable data from unprintable data, the server must be capable of transmitting both printable data and unprintable data to the printer.

Shima-894 also discloses a URL storage subsection within the network printer for storing a URL specified by the host computer (column 6, lines 10-11; 20 in Fig1). Based on the established meaning of a URL, the scope of this subsection is identical to the scope of the current invention *designating system to designate one of a plurality of locations, which are indicated by the location data, corresponding to the print data to be printed.*

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 5-7, 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shima (US 6,362,894 B1; Date of Patent: Mar. 26, 2002; Effective Filing date Nov. 25, 1998) ('Shima-894') in view of Shima (US 6,867,874 B1; Date of Patent: Mar. 15, 2005; Effective Filing date Nov. 16, 1999) ('Shima-874').**

With regards to dependent claims 5 and 12, Shima-894 discloses a process to determine whether the data received by the printer is printable or unprintable data.

Shima-894 uses a format management table to determine whether the format of specific data is receivable (print data) or un-receivable (*unprintable data*) (column 6, lines 11-18; Fig 2). Even though Shima-894 doesn't explicitly state that both printable and unprintable data are stored on the server, and that the location data generating system generates a location for both, and transmits them, this is nevertheless implied, because in order for the printer to distinguish printable data from unprintable data, the server must be capable of transmitting both printable data and unprintable data to the printer.

Shima-894 also discloses a URL storage subsection within the network printer for storing a URL specified by the host computer (column 6, lines 10-11; 20 in Fig1). Based

on the obvious meaning of an URL, the scope of this subsection is identical to the scope of the current invention *designating system to designate one of a plurality of locations, which are indicated by the location data, corresponding to the print data to be printed.*

Even though it is inherent that the designating system would have means for extracting location data of the print data from location data received, Shima-894 does not disclose expressly that the *designating system includes an extracting system that extracts the location data of the print data from the location data received by the location data receiving system.*

However, Shima-874 discloses the printer analyzes the text of the resources received from the server, *extracts the URL (location data) of the structural data and sends a transfer request of the structural data in accordance with the URL (column 3, lines 16-19).*

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide a mechanism for extracting the URL from the location data, providing the benefit of determining the location of the print data.

With regards to dependent claims 6 and 13, as with the current invention, Shima-894 discloses a process to determine whether the data received by the printer is printable or unprintable data. Shima-894 uses a format management table to determine whether the format of specific data is receivable (print data) or un-receivable (*unprintable data*) (column 6, lines 11-18; Fig 2). Even though Shima-894 doesn't explicitly state that both printable and unprintable data are stored on the server,

and that the location data generating system generates a location for both, and transmits them, this is nevertheless implied, because in order for the printer to distinguish printable data from unprintable data, the server must be capable of transmitting both printable data and unprintable data to the printer.

Shima-894 does not disclose expressly that *said transmitting system selectively transmits only the location data of the print data*. However he does disclose that in one embodiment of his invention, only preset information of specified information resources is received and printed (column 7, lines 34-35). Using the broadest interpretation of this statement, the examiner presume that if one were to preset specific information about the resources that were to be received, then only those selective resources would be transmitted based on the preset information. Therefore, the examiner concludes that this preset information could include *only transmitting the location data of the print data*, as oppose to transmitting both print data and unprintable data.

Therefore it would have been obvious to combine Shima-874 with Shima-894 for the benefit of being able to selectively determine the specific type of data that the server is to transmit.

With regards to dependent claims 7 and 14, as with the current invention, Shima-894 discloses a process to determine whether the data received by the printer is printable or unprintable data. Shima-894 uses a format management table to determine whether the format of specific data is receivable (print data) or un-receivable (*unprintable data*) (column 6, lines 11-18; Fig 2). Even though Shima-894

doesn't explicitly state that both printable and unprintable data are stored on the server, and that the location data generating system generates a location for both, and transmits them, this is nevertheless implied, because in order for the printer to distinguish printable data from unprintable data, the server must be capable of transmitting both printable data and unprintable data to the printer.

Shima-894 does not disclose expressly that *said transmitting system includes an extracting system that extracts the location data of the print data from the location data stored in said location data storage, said transmitting system transmitting the location data extracted by said extracting system.*

However, Shima-874 discloses that the web server transmits resources requested by the printer based on the printer's request message in accordance with an URL (column 4, lines 34-39). Therefore, the examiner concludes that if the printer has a mechanism for extracting the URL (*location data*) from the resources transmitted by the server, and a mechanism for including an URL (*location data*) in its request for resources to the server, then inherently the transmitting system on the server would have a mechanism for *extracting* the URL (*location data*) of the print data in storage, so it can be included in the response message to the printer.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide a mechanism for *extracting* the URL (*location data*) of the print data in the data storage in order to include it in the resource information that is transmitted to the printer in response to the printer's request of the specified resources.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James J. Debrow whose telephone number is 571-272-5768. The examiner can normally be reached on 8:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James J. Debrow
Examiner
Art Unit 2176

William L Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
10/27/2005